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EXAMINER

HARRIS, CHANDA L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 08/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,123

Applicant(s)

SIRHALL, THOMAS M. *CM*

Examiner

Chanda L. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-13 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

In reply to the response filed on 7/22/03, Claims 1-2, 5-8, 11-13, and 17-20 are pending.

Specification

The use of the trademarks HOTJAVA, NETSCAPE NAVIGATOR, AND JAVA have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1-2, 5 and 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Bolton, pages 3-5.

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1. [Claims 1,5]: Regarding Claims 1 and 5, Bolton discloses providing an interactive fill-in-the-blank applet, wherein said applet generates a graphical user interface displaying a text box, a question and instructions to a user to enter an answer to the question in the text box. See p.3. Bolton discloses forwarding the applet from the electronic device to a remote client, wherein said applet automatically provides a correct answer in the text box after the user surpasses a predetermined number of attempts, and prevents the user from entering an answer after said predetermined number of attempts. See p.4.
2. [Claim 2]: Regarding Claim 2, Bolton discloses wherein said applet provides feedback to the user indicating whether an answer entered by the user is correct (i.e. 'Sorry, the correct answer is 'dash)'). See p.4.
3. [Claim 17]: Regarding Claim 17, a processor, a display screen, and a memory including a Web page having an interactive fill-in-the-blank applet embedded therein would have been inherent features of Bolton's invention enabling the execution of Bolton's invention. See pp.3-5.
4. [Claims 18-19]: Regarding Claims 18-19, a browser for locating and displaying said Web page and a network connection for connecting said electronic device to a computer network would have been inherent features of Bolton's invention enabling the execution of Bolton's invention.
5. [Claim 20]: Regarding Claim 20, Bolton discloses input media (i.e. text box) to allow the user to enter said answer. See pp.3-5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields et al. (US 6,347,943) in view of Sonnenfeld (US 6,112,049).

1. [Claim 6]: Regarding Claim 6, Fields discloses receiving a request for a Web page (i.e. HTML document) from a remote client. See Col.7: 46-50. Fields discloses in response to said receiving step, sending a Web page (i.e. assessment page) containing a fill-in-the- blank question. See Col.2: 39-42.

Fields does not disclose expressly an applet. Instead, Fields discloses the use of HTML page types. See Col.6: 11-14. Moreover, he teaches the EPSS being accessible from an applet viewer (Col.4: 20-23), thus making Fields' invention capable of being implemented by the use of applets. Therefore, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to incorporate an applet into Fields because Applicant has not disclosed that an applet provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected

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Applicant's invention to perform equally well with HTML documents because both data types perform the same function of providing a fill-in-the-blank question to the user.

Fields does not disclose expressly a definition file that is unavailable to the user, defining a correct answer to the question such that the definition file is separate from a source code for said Web page to prevent a user from obtaining the correct answer by viewing the source code. However, Sonnenfeld teaches a definition file that is unavailable to the user (i.e. read in by the ITS as opposed to a skeleton file), defining a correct answer (e.g. certain keywords) to the question such that the definition file is separate from a source code (i.e. skeleton HTML file) for said Web page to prevent a user from obtaining the correct answer by viewing the source code (i.e. making the answers to the questions unavailable to the user). See Col.22: 39-Col.23: 15.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Fields, in light of the teaching of Sonnenfeld, in order to prevent others from knowing the correct answers and to enable the test designer to give out the test again at a later time. Further, Applicant provides further support for the matter of design choice on page 5, lines 23-30 of the specification.

2. [Claim 7]: Regarding Claim 7, Fields discloses wherein said Web page comprises a page (i.e. HTML page type) of an on-line educational course. See Col.6: 9-11.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fields/Sonnenfeld as applied to claim 6 above, and further in view of Bolton, page 6.

[Claim 8]: Regarding Claim 8, Fields/Sonnenfeld does not disclose expressly wherein said Web page includes an applet tag instructing a browser to execute instructions for running the fill-in-the-blank applet. However, Bolton teaches an applet tag (i.e. APPLET CODE) on page 6. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate wherein said Web page includes an applet tag into the method and system of Fields/Sonnenfeld, in light of the teaching Bolton, in order to provide the code for implementing the fill-in-the-blank applet.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton in view of Sonnenfeld.

1. [Claim 11]: Regarding Claim 11, Bolton discloses instructions for running a fill-in-the-blank applet for displaying a question and a text box to a user, wherein the user can enter an answer to the question in the textbox, the medium including hypertext markup language (HTML) code and a reference to the applet (i.e. APPLET CODE). See pp.3-6.

Bolton does not disclose expressly HTML code that includes the question. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to incorporate the question into Bolton because Applicant has not disclosed that incorporating the question provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the

art, furthermore, would have expected Applicant's invention to perform equally well with referencing the question via the applet code because both sets of code perform the same question of presenting a fill-in-the-blank question to the user.

Bolton does not disclose expressly a definition file, included in the applet and unavailable to the user, indicating a correct answer for said question, said definition file being separate from the HTML code to prevent the user from obtaining the correct answer by looking at the source code. Though, one cannot obtain the correct answer by looking at the source code of Bolton on p.6. However, Sonnenfeld teaches a definition file that is unavailable to the user (i.e. read in by the ITS as opposed to a skeleton file), indicating a correct answer (e.g. certain keywords) to the question such that the definition file is separate from the HTML code (i.e. skeleton HTML file) to prevent a user from obtaining the correct answer by looking at the source code (i.e. making the answers to the questions unavailable to the user). See Col.22: 39-Col.23: 15. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate wherein said Web page includes an applet tag into the method and system of Bolton, in light of the teaching Sonnenfeld, in order to provide the code for executing the fill-in-the-blank applet.

2. [Claim 13]: Regarding Claim 13, Bolton/Sonnenfeld does not disclose expressly wherein instructions are stored on a server and downloaded to a local processor of the user. However, storing instructions on a server and downloading them to a local processor of the user is old and well-known in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the

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aforementioned limitation into the method and system of Bolton/Sonnenfeld in order to enable a faster response time over the network.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton/Sonnenfeld as applied to claim 11 above, and further in view of Fields.

[Claim 12]: Regarding Claim 12, Bolton/Sonnenfeld do not disclose expressly wherein the instructions are executable on a virtual machine. However, Fields teaches such in Col.4: 17-20. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate instructions that are executable on a virtual machine into the method and system of Bolton/Sonnenfeld, in light of the teaching of Fields, in order to enable platform-independent execution of Java programs.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hamalainen et al. (US 2003/0060284)
 - interactive question-based applications
- Walker et al. (US 5,947,747)
 - computer-based educational testing
- Futakuchi (US 2001/0051330)
 - remote teaching

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Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Therefore, this action is made NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ch.

ch.

August 1, 2003

Chanda L. Harris
Examiner
Art Unit 3714


JESSICA HARRISON
PRIMARY EXAMINER